Application Serial No. 10/564,771   PATENT Docket: CU-4657

RECEIVED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE CENTRAL FAX CENTER

JUN 03 2009

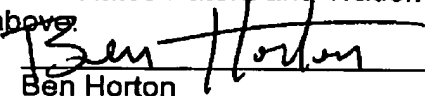|	
In re Application: Yong-Ju CHO et al.	] Art Unit: 2161
Serial No: 10/564,771	] Ex.: Jacob, Ajith
Filed: March 14, 2006	]

For: METHOD AND APPARATUS FOR ADDRESSING MEDIA RESOURCE, AND RECORDING MEDIUM THEREOF

Certification under 37 C.F.R. §1.8(a)

The USPTO Central Fax No. (571) 273-8300

Date of Fax Transmittal:_____June 3, 2009_____

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted to the United States Patent and Trademark Office to the fax number and on the date indicated above.

Ben Horton

PRE-APPEAL BRIEF ARGUMENTS AND REMARKS

MAIL STOP AF
The Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

This pre-appeal review is requested for U.S. Serial No. 10/564,771 ("the Present Application") filed March 14, 2006. The outstanding final office action mailed March 5, 2009 rejects claims 1-4, 6-8, and 14-15 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Pub. No. 2003/0108205 (Joyner).

BACKGROUND: Independent claims 1, 8, 14, and 15 are directed to, inter alia, a media resource addressing method and device for an MPEG (motion picture experts group)-21 file format using a DID (digital item declaration). The DID is based on the ISO media file format and although basic structures for storing media contents have been proposed, no detailed methods for addressing media resources in the DID have been previously disclosed.

As pointed out in the amendment of December 16, 2008, the Present Application discloses a method and device for --extracting a corresponding media resource according to reference information of the media resource recorded in the DID--. That is,

Application Serial No. 10/564,771   PATENT Docket: CU-4657

the Present Application discloses steps as they relate to the acts performed on the DID in order to generate a media file after addressing the media resources extracted from the DID.

The Pre-Appeal Review process provides that "a panel of examiners formally review the legal and factual basis of the rejections" prior to filing of an appeal brief. In this brief, the applicants therefore identify (1) the presence of clearly improper rejections based upon the examiner's errors in facts; and (2) the omission of essential elements required to establish a prima facie rejection. (See OG Notices: 12 July 2005.)

ERROR IN FACTS #1: Unlike the presently claimed invention, Joyner never teaches or suggests the extraction of media resources according to reference information recorded in the DID (see the current final office action page 2 for the examiner's allegations). To the contrary, Joyner doesn't mention the term DID or digital item declaration anywhere within the specification of Joyner. Rather, Joyner merely mentions "MPEG-21" in paragraph [0026] of Joyner as one of a plurality of "commonly used digital compression[s]."

It is this paragraph, i.e., Joyner [0026], upon which the examiner supports the allegation that Joyner inherently teaches DID extraction (see current final office action page 7 for the examiner's allegations). Paragraph [0026] of Joyner states that content providers 104 will convert content from analog to digital and if necessary, compress the content (Joyner [0026]). The content provider 104 "then provides the content to the server 102 in a compressed digital format" (Joyner [0026]). Joyner then proceeds to list "some of the more commonly used digital compression standards [that] are produced by the Moving Picture Experts Group ("MPEG")" of which MPEG-21 is mentioned (Joyner [0026]). This is the full extent of the teaching of Joyner with respect to an MPEG-21 file. The examiner relies on this sole mention of MPEG-21 within a list of "more commonly used digital compression standards" as inherently teaching steps relating to DID extraction.

Joyner is not directed to the creation of an MPEG-21 file as alleged by the examiner (see current final office action page 7 for the examiner's allegations). To the contrary, Joyner is directed to the improved "delivery of encrypted data via a network by encrypting the data with a symmetric key before it is requested and then storing the encrypted data and the symmetric key for later retrieval and transmission" (Joyner

Application Serial No. 10/564,771   PATENT Docket: CU-4657

[0004]). That is, Joyner is directed to a system and method for encrypting content **after** it has been provided to the system of Joyner. Considering paragraph [0026] and FIG. 1 of Joyner, it is clear that the content provider 104 provides data to the server 102 upon which encryption and storage occurs. As stated in paragraph [0026] of Joyner, the data provided by the content provider 104 may be one of commonly used digital compression standards such as MPEG-21. However, it is clear from reading Joyner that the system and method of Joyner plays no role in the creation of a file using the commonly used digital compression standards. Rather, the system and method of Joyner is directed solely to post-processing activities of an already compressed digital content provided from the content provider 104.

This has been repeatedly argued in the amendments filed on December 18, 2007 (pages 10-11), June 17, 2008 (pages 11-14), and December 16, 2008 (pages 10-13). Despite these arguments, this factual assertion made by the examiner that the recitation of MPEG-21 in paragraph [0026] of Joyner inherently teaches steps relating to a DID has been made in the current and prior office actions, and the applicant submits that this clearly is an error in facts in rejections of claims 1, 8, 14, and 15.

ERROR IN FACTS #2: The examiner cites paragraph [0029], [0034], and FIGS. 4A-4B of Joyner as teaching the storing of generated standard location information in the meta data box of the media file and the storage of the extracted media resource in the media data box of the media file. FIG. 1 of the Present Application shows a conceptual diagram of the WD1.1-based ISO media file format. That is, the meta-data box 110 and media data box 120 shown in FIG. 1 are regions of the actual MPEG-21 file (specification [0023-0027]). Paragraphs [0029], [0034], and FIGS. 4A-4B of Joyner relied upon by the examiner teach storage of encrypted content in a data storage device 116 (Joyner [0029]; [0034]). This is clearly not the same as the media data box 120 and meta-data box 110 of the WD1.1-based ISO media file format as in the Present Application. The applicants have argued in the previous filed responses that the physical data storage device 116 is not a part of a WD1.1-based ISO media file format as in the presently claimed invention. The examiner has responded in the current final office action that Joyner teaches, "different boxes of data stored within one file as visually displayed in FIG. 4A and 4B" (see current final office action page 7 for the examiner's allegations). However, FIGS. 4A and 4B do not represent data boxes of a

Page 3 of 5

file as alleged, but rather teach a "block diagram of a decryption/encryption path of a device (client)" (Joyner [0012-0013]). The examiner's assertion that FIGS. 4A-4B somehow represent the blocks of a data file is without any factual support and is in direct contradiction to Joyner's own description of FIGS. 4A and 4B. This has been repeatedly argued in the previously filed response, yet the examiner has yet to provide any explanation as to how the "block diagram of a decryption/encryption path" of FIGS. 4A-4B represent "different boxes of data stored within one file" as alleged. The applicants respectfully submit that this is an error in facts #2 in rejection of claims 1, 8, 14, and 15.

ERROR IN LAW #3: Essential elements needed for a prima facie rejection has been omitted in the outstanding office action page 2 alleging that Joyner discloses "extracting based on multimedia content description and framework, 0026" and "storage of extracted data, 0027 and in one file, 0034 and Figure 4A."

The presently claimed invention includes extracting or reading information of a media resource recorded in a DID and storing information generated in a media data box and a meta-data box. Joyner teaches no such equivalent steps or processes. Rather, Joyner is completely silent as to a DID. The examiner as support states "[t]he accepting, storing and distribution of content as taught in Joyner et al. [0026] clearly teaches the use of a DID, since one of the formats listed is MPEG-21 which has DID language defined therein" (see current office action page 8).

For a *prima facie* case of anticipation, the reference must teach every element of the claim. MPEP § 2131 states (emphasis added):

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... **"The identical invention must be shown in as complete detail as is contained in the ... claim."** *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)."

A prima facie case of anticipation is not established merely by the statement made in the outstanding office action page 8, as this clearly falls short of the requirement that the analysis supporting an anticipation rejection requires that each and every element of the claims must be set forth in a single prior art reference (MPEP §2131). To support this rather simple rationale, the examiner has relied on Joyner paragraph [0026] that mentions that MPEG-21 may be one of numerous digital

Application Serial No. 10/564,771   PATENT Docket: CU-4657

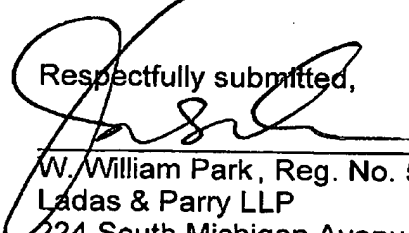compression standards that may be provided by a content provider 104.

Absent from Joyner, as well as any argument set forth by the examiner, are steps pertaining to the reading/extracting of information from a DID. There is absolutely no mention of a DID anywhere within Joyner and the examiner's sole reliance of an MPEG-21 format listed in paragraph [0026] as teaching, in essence, the entire invention of the Present Application blatantly ignores the examiner's burden of proof in demonstrating that Joyner teaches each and every element of independent claims 1, 8, 14, and 15.

Further, to support the examiner's allegation that such mention of an MPEG-21 format inherently teaches processes relating to a DID, the examiner must provide rationale or evidence tending to show inherency (MPEP § 2112(IV)). The examiner has failed to provide a basis in fact and/or technical reasoning to support that the use of a DID necessarily flows from the teachings of Joyner describing a distribution of encrypted content system that may include an MPEG-21 file.

These arguments have been repeatedly made in the responses filed on December 18, 2007, June 17, 2008, and December 16, 2008. However, the examiner has only responded by stating that paragraph [0026] of Joyner inherently teaches the steps of the presently claimed invention without any rationale as to how Joyner does so. Further, the examiner has continually failed to address the applicants' argument that method and system of Joyner is applicable to a file after its formation. That is, Joyner is directed to a method of distribution of encrypted content provided by content providers 104 and in no way discloses any steps relating to the generation of such content. If the examiner's argument were considered to be valid, Joyner would also server as a prior art reference for any method of generating an MPEG-1, MPEG-2, MPEG-4, and MPEG-7 file also disclosed in paragraph [0026] of Joyner. In reading Joyner, a person having ordinary skill in the art would be unable to make such a determination.

Respectfully submitted,

Dated: _June 3, 2009_

W. William Park, Reg. No. 55,523
Ladas & Parry LLP
224 South Michigan Avenue
Chicago, Illinois 60604
(312) 427-1300

Page 5 of 5